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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/385,394 | 08/30/1999 | JOHN S. YATES JR. | 114596/03-4000. | 9093 |

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EXAMINER

ELLIS, RICHARD L

ART UNIT PAPER NUMBER

2183

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/385,394

Applicant(s)

YATES ET AL.

Examiner

Richard Ellis

Art Unit

2183

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 4/14, 4/18, 4/28/05 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 28 April 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 1-21, 37-50, 113-116 and 119-133.
Claim(s) objected to: 34-36, 60, 67 and 86.
Claim(s) rejected: 22-33, 51-59, 63-66, 68-85 and 87-112.
Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 4/14 and 4/18/05
13. ☒ Other: See Continuation Sheets.

**RICHARD L. ELLIS
PRIMARY EXAMINER**

Continuation of 3. NOTE: New language added to claim 63 would require further search and consideration..

Continuation of 13. Other: The IDS submissions of 4/14 and 4/18/2005 have not been considered because they fail to include both the required fee for consideration as well as a statement of timely submission as required by 37 CFR 1.97.

Attachment to advisory action.

1. It is noted that applicant's submission of 4/8/2005 and 4/14/2005 contain a petition to withdraw finality and request to withdraw finality. Unfortunately, during the scanning process of the documents into the office's IFW system, these two documents were mis-indexed and identified as an incorrect paper type by the scanning contractors. The result of this mis-identification is exactly equivalent to a lost paper under the previous paper based system. These two documents have now been forwarded to the appropriate deciding official for appropriate action.

2. As to applicant's assertion that references of the July 2004 IDS were not considered, applicant is clearly in error.

Were applicant to have compared the signed copy of the IDS of July 15, 2004 which was supplied to applicant on 10/25/2004 with the same sheets of the July 15, 2004 IDS which was supplied to applicant on 2/14/2005, applicant would have recognized that between the two corresponding sheets, all references have been indicated considered.

For example, were applicant to have compared page 5 as mailed to applicant on 2/14/2005 with page 5 as mailed to applicant on 10/25/2004, applicant would find that the 10/24/2004 sheet indicates consideration of all US Patent documents submitted. Page 5 as supplied on 2/14/2005 simply additionally considers foreign document WO 99/08191 to Kelly which was lined through on the paper supplied on 10/25/2004. Both documents, the one supplied on 10/25/2004 and the one supplied on 2/14/2005, are present within the file wrapper, and the **COMBINATION** of both documents controls what was considered, not one or the other document in isolation.

Similarly, a comparison of page 6 of both documents shows that the combination of the two documents indicates consideration of all listed non-patent literature. Similarly, a comparison of page 7 of both documents indicates a consideration of all listed non-patent literature.

Accordingly, all properly submitted IDS information was considered, and applicant is

clearly in error in asserting otherwise.

3. Applicant is additionally in error in asserting that the advisory action misstates the law.

The pertinent portion of 37 CFR § 1.98 is:


(d) A copy of any patent, publication, pending U.S. application or other information ... is required to be provided ... unless:

(1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

Section (d)(2) of 37 CFR § 1.98 very clearly indicates that in order to not supply copies of references in a current IDS, the previous IDS where the references were supplied must comply with paragraphs (a) through (c). In order for a previous IDS to comply with paragraph (a), a copy must be provided of all cited references. Therefore, in order for paragraph (d) to apply, the previous IDS must comply with paragraph (a) and provide a copy.

As the only application for which this application relies upon for a filing date under 35 USC § 120 is parent case 09/322,443, and the IDS in parent case 09/322,443 did not provide a legible copy, thereby complying with paragraph (d) and failing to comply with paragraph (a), a copy of the reference was required to be submitted in this case in this IDS submission. I.e., the IDS in case 09/322,443 did not comply with paragraph (a), therefore, paragraph (d) is not applicable because paragraph (d)(2) requires compliance with paragraph (a) in the earlier IDS.


RICHARD L. ELLIS
PRIMARY EXAMINER